

REMARKS

Claims 1-5 are pending the present application. Claim 1 has been amended herein.

Support for the claim amendment may be found, at least, at page 4, lines 1-14 and 22-27 of the specification and in the Drawings. Applicant submits that no new matter has been added by way of the above amendments.

Claim Rejections Under 35 USC §103(a)

Claims 1 and 3-5 stand rejected as being rendered obvious by USP 5,484,430 to Osborn, III (“**Osborn**”) in view of USP 6,315,765 to Datta et al. (“**Datta**”).

Claim 2 stands rejected as being rendered obvious by Osborn in view of Datta and further in view of US Patent Publication 2003/0093045 to Erdman (“**Erdman**”).

Applicant respectfully traverses each of the outstanding rejections.

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit

showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

The Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007) reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The Court in *KSR Int’l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to

meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

The Advantages of the Present Invention

The disposable diaper of claim 1 is superior to the prior art because orientation of the absorbent members and the elastic members facilitates conformity to the wearer's body configuration, thereby preventing bagging of the absorbent members and providing snug fit.

For example, the disposable diaper of claim 1 has advantages in that the presence of the boundary between the absorbent members in the crotch portion and the front portion of the diaper, which boundary is slightly before the middle of the diaper length and towards the front of the diaper (*see Figures 1 and 2 below*) allows the diaper to be easily folded along the wearer's body configuration, thus further preventing bagging of the diaper's absorbent members, and thereby providing a snug fit to the wearer.

Likewise, the elastic members (7) that are "disposed longitudinally on both lateral sides of the disposable diaper from the rear portion absorbent member to the front portion absorbent member" have an advantage in that they can function to form leg gathers in the leg portions, while also helping to ensure a snug fit of the to the wearer.

Fig.1

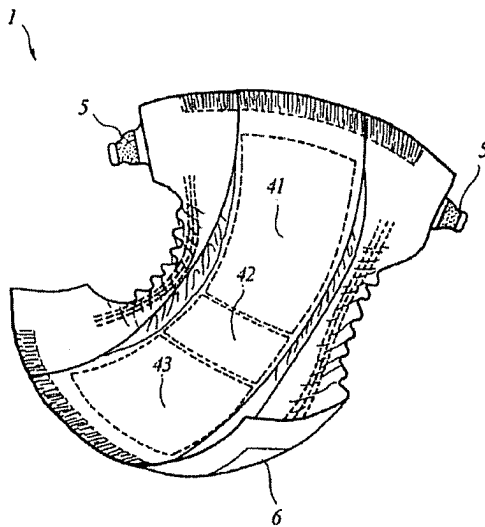
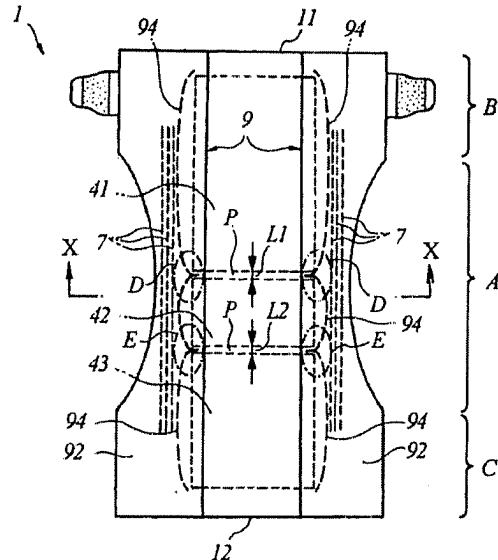


Fig.2



Discussion of the Cited Prior Art

None of the cited prior art, alone or taken together, teaches or suggests a disposable diaper according to present claim 1. In particular, **Osborn, Datta** and **Erdman** do not teach or suggest the following recited limitations in instantly amended claim 1:

...elastic members being disposed in a stretched state on both sides of said series of said three absorbent members, such that when said diaper is worn, the elastic members are disposed on the leg portions around the wearer's legs, and wherein the elastic members are disposed longitudinally on both lateral sides of the disposable diaper from the rear portion absorbent member to the front portion absorbent member,...

...said three absorbent members being disposed in series in the direction of from the rear portion, through the crotch portion, to the front portion of the diaper, and wherein the length of the three absorbent members descends in the order of the rear portion absorbent member, the front portion absorbent member and the crotch portion absorbent member,...

wherein a boundary between the absorbent members in the rear and crotch portions is positioned at about the middle of the diaper length, and a boundary between the absorbent members in the crotch portion and front portion is slightly before the middle of the diaper length and toward the front of the diaper.

In view of the foregoing, Applicant believes the pending application is in condition for allowance. A Notice of Allowance is earnestly solicited.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Monique T. Cole, Reg. No. 60,154 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: AUG 09 2007

Respectfully submitted,

By 

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